



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/219,267	12/23/1998	JAY S. WALKER	98-109	2012
22927	7590	09/07/2007	EXAMINER	
WALKER DIGITAL MANAGEMENT, LLC			NGUYEN, TRI V	
2 HIGH RIDGE PARK			ART UNIT	PAPER NUMBER
STAMFORD, CT 06905			1751	
MAIL DATE		DELIVERY MODE		
09/07/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/219,267	WALKER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Tri V. Nguyen	1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 21 June 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-44,46-50 and 56-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-44,46-50,56-62 and 65-80 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1751

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/06/07 has been entered.

### ***Response to Amendment***

2. In the supplemental amendment filed on 06/21/07, Claims 1, 24, 50, 56, 61 and 62 have been amended; Claims 63 and 64 have been cancelled and Claims 71-80 have been added. The currently pending claims considered below are Claims 1-44, 46-50, 56-62 and 65-80.

### ***Claim Objections***

3. Claims 71, 72 and 75-80 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 71, 72 and 75-80 are dependent claims that are directed to computer readable media and apparatus of method claims.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1751

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19, 33, 42-44, 49, 56-60, 62-64, 71-76, 79-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US 6,0555,513) in view of Logan et al. (5,21,827) and Brian Donlon ("Cable industry channels its efforts in April; sampler of specials." USA Today. McLean, VA: Mar 29, 1990. page 3D - hereon referred to as Donlon) or Anonymous ("Manufacturers shine with cross-promotional prowess." Discount Store News. New York: Aug 5, 1996, vol 35, Iss 15, page 19 - hereon referred to as Discount Store News).

Claim 1: Katz et al. disclose a method for providing a discount to a customer which includes:

a. Receiving an indication that a customer is to purchase an item from a merchant (col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6),

in which none of the at least one item requires a service agreement for its use;

b. selecting, by a computing device, a second merchant from a plurality of merchants;

c. providing, in response to the received indication, an offer for a benefit (discount/subsidy) from the second merchant, the step of providing the offer being performed before the at least one item is purchased (col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6),

in which the offer is not provided unless and until the indication of the at least one item that the customer is to purchase from the first merchant is received;

c. Receiving a response from the customer accepting the offer (col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6); and

d. Applying the benefit (discount/subsidy) to the item (col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6).

In an analogous art, Donlon or Discount Store News teaches that it is known to use a cross-marketing approach to sell a product at discount via a subsidy from a second vendor to provide an incentive to the purchaser of the product (Donlon: abstract or Discount Store News: abstract and page 1, parag. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

Art Unit: 1751

modify the method as taught by Katz, with the cross-marketing approach as taught by Donlon or Discount Store News. One would have been motivated to modify the method with subsidizing for the price of a product/service with a related product/service for providing an incentive for the purchase of the initial product/service thus enhancing customer base via a combination of products and achieving greater profitability. While Katz et al. and Donlon or Discount Store News do not explicitly disclose that the offer is from a second merchant who has been selected from a plurality of merchants based on the customer information, Logan discloses a similar method and further discloses providing an offer from a second merchant selected from a plurality of merchants based on the customer information (col 9, lines 23-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use customer information to present an offer to the customer. One would have been motivated to select the offer from a plurality of secondary merchants in order to give the customer greater latitude in the selection of the providers, thus increasing the likelihood that the customer would accept the offer.

Claim 2: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and Katz further discloses receiving customer information (Katz et al.: col 19, line 24 to col 20, line 23).

Claims 3, 4, and 33: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 2 and further disclose that the customer information includes a service or service provider (Katz et al.: see abstract; col 21, lines 9-31 and Donlon: abstract).

Claim 5: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 2 above, and Loqan further discloses providing an offer from a second merchant selected from a plurality of merchants based on the customer information (col 9, lines 23-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use customer information, such as an indicated preference for a service provider. One would have been motivated to select the offer from a plurality of secondary merchants in order to give the customer greater latitude in

Art Unit: 1751

the selection of service plans and providers, thus increasing the likelihood that the customer would accept the offer.

Claim 6: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 2 above, and Katz et al. further discloses providing an offer based on the customer information (Katz et al.: col 17, line 37 to col 18, line 15).

Claim 7: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 2 above, and Katz et al. further discloses requesting and receiving customer information from the customer (Katz et al.: col 17, line 37 to col 18, line 15).

Claims 8 and 9: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 7 above, and Katz et al. further discloses transmitting a question to the customer and receiving the customer's answer (Katz et al.: col 17, line 37 to col 18, line 15).

Claim 10: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 2 above, but do not disclose verifying the accuracy of the customer information. Official Notice is taken that it is old and well known within the information arts to verify incoming data, such as customer information (see col 9, lines 9-14 of Woolston, 5,845,265, submitted by Applicant as item EE on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to verify the customer information upon receipt. One would have been motivated to verify the accuracy of the information in order to ensure the database is kept as up-to-date and as accurate as possible in the offer selection process.

Claims 11-13: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 10 above, but do not disclose assessing a penalty if the customer information is not accurate. Official Notice is taken that it is old and well known within the information arts to penalize users when the entered information, such as log-in and password information, is not accurate. It is also well known that this penalty may take

Art Unit: 1751

many forms, such as monetary, denial of service, disconnection, etc. (see col 4, lines 33-39 of Baker et al 5,884,292, submitted by Applicant as item FF on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to penalize the customer for inaccurate information. One would have been motivated to penalize the customer in one of these manners in order to ensure the accuracy of the information retained in the database and to enforce any limitations on the benefit, such as the number of times a customer may receive the benefit within a specified time period, etc.

Claim 14: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 10 above, but do not disclose verifying the information prior to consummating the purchase. Official Notice is taken that it is old and well known and would have been obvious to one having ordinary skill in the art at the time the invention was made to verify the customer information prior to processing the transaction (see col 4, lines 33-39 of Baker et al, 5,884,292, submitted by Applicant as item FF on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). One would have been motivated to ensure this prior to completing the transaction in order to prevent entry of fraudulent or inaccurate information into the database, to ensure the purchased item is delivered to the correct address, and to ensure that the credit card data is correct prior to releasing the merchandise to the customer.

Claims 15 and 16: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 2 above, and Katz et al. further discloses providing the offer after receiving and based upon the customer information (Katz et al.: col 17, line 37 to col 18, line 15).

Claim 17: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, but does not disclose receiving the customer information from a third party (Katz et al.: col 17, line 37 to col 18, line 15).

Art Unit: 1751

Claim 18: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 2 above, and Katz et al. further discloses that the customer information includes the location or Internet address of the customer (Katz et al.: col 17, line 37 to col 18, line 15).

Claim 19: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and Katz et al. further discloses that the benefit is a reduced price (discount) for the item (subsidized price) (Katz et al.: col 17, line 37 to col 18, line 15; Donlon: abstract or Discount Store News: abstract and page 1, parag. 3).

Claim 42: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and Katz et al. further discloses providing the offer only when a predetermined rule is satisfied (Katz et al.: col 17, line 37 to col 18, line 15).

Claims 43 and 44: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and Katz et al. further discloses provide a plurality of offers from the merchant and receiving an indication of a selected offer from the customer (Katz et al.: col 17, line 37 to col 18, line 15).

Claim 49: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and but do not explicitly further discloses receiving a payment from the second merchant upon acceptance of the offer. However, it would have been obvious to a skilled artisan at the time of the invention that the subsidy has to funded and that provider of the subsidy is the funding party (Donlon: abstract or Discount Store News: abstract and page 1, parag. 3).

Claims 56-60, 63, 73 and 74: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and Katz et al. discloses transmitting a form to the customer who completed the form and returns it to the system (Katz et al.: col 17, line 37 to col 18, line 15). However, Katz et al. does not disclose that the offer is a discount based on the customer's application for a credit card; nor that the customer completes and submits an application form online after the system determines that the

Art Unit: 1751

customer does not already have another credit card account with the credit card issuer. Official Notice is taken that it is old and well known within the marketing arts to make promotional offers to customers who will complete and submit application forms for credit cards (see the Times Newspaper article by Stephen Ellis, "Credit card forms drive down costs", submitted by Applicant as item GG on the Information Disclosure Statement filed on May 19, 1999, paper number 5, which is cited in support of this Official Notice). These offers are not only made at a merchant's point of sale, but are prevalent throughout our "plastic" society. Indeed, with the advent of "sponsored" credit cards several years ago, such as banks and even gasoline companies issuing VISA cards, surveys have shown that each American receives dozens of such offers each year. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a promotion based on a credit card application by the customer. One would have been motivated to use such a promotion in order to increase the amount of credit available to the customer, thus enticing the customer to spend more at the merchant. One would have been motivated to ensure that the customer did not already have an account with the credit card issuer in order to avoid providing an excessive credit limit to a customer.

Claim 62: Katz et al., Donlon or Discount Store News and Logan disclose the method of Claim 1 above, and

Logan further discloses generating a customer interface for allowing the customer to interact with the system (col 10, lines 51-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the Radio Shack customer to interact with the system via a customer interface. One would have been motivated to use such a customer interface to facilitate completion of the application form by the customer, thus eliminating the need to use a facsimile machine to send the completed form to Sprint.

Claim 64: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 63 above, and

Katz et al., Donlon or Discount Store News and Logan further discloses charging the amount, based on the difference between total price and price charged, to the customer,

Art Unit: 1751

but does not explicitly disclose that it is charged to the customer's credit card. Official Notice is taken that it is old and well known within the retail arts for customers to make purchases using credit cards. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the Radio Shack customer to credit the purchase price to a credit card account. One would have been motivated to charge the purchase price to a credit card account in order to eliminate the need for handling large amounts of cash by the customer and merchant.

Claims 71, 72, 75, 76, 79 and 80 describe the apparatus and instructions of the method claims 1, 56 and 62 thus the prior art references of Katz et al., Donlon or Discount Store News and Logan as set forth above are relied upon to reject claims 71, 72, 75, 76, 79 and 80.

6. Claims 29-32, 61, 65 and 77-78 are rejected under 35 U.S.C. 103(a) as unpatentable over Katz et al., Donlon or Discount Store News and Logan and further in view of the articles of "Selling a free phone" by Dana Spoor, Cellular Business v1n2, pp 58-62, Feb 1994, Dialog File 15, Record # 00825327, hereinafter Spoor and "Credit Card firms drive down costs" by Stephen Ellis, Times Newspapers Limited, Sunday times, Feb. 27, 1994.

Claims 29-32: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and but do not explicitly further disclose requesting the customer to participate in a transaction with a second merchant, receiving an indication from the customer agreeing to such participation, and that the agreement is to initiate a service contract with the second merchant. Katz et al. disclose the feature of selecting a service provider in the upsell process. In an analogous art, Spoor teaches a cross-marketing scheme with the feature of a service provider (Spoor: page 1, parag. 7-8 and page 2, parag.4). The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Art Unit: 1751

Claims 61 and 65: Katz et al., Donlon or Discount Store News and Logan disclose a method comprising:

a. receiving an indication that a customer is willing to make a purchase from a first merchant (Katz. et al.: col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6)

in which the purchase does not include any item that requires a service agreement for its use;

b. receiving information about the customer,

in which the information about the customer does not include information about the purchase (Katz. et al.: col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6);

c. selecting a second merchant from a plurality of merchants;

d. transmitting, in response to the indication, customer information to the second merchant;

e. receiving, from the second merchant, a description of a subsidy;

f. providing an offer for the subsidy from the second merchant, the step of providing the offer being performed before the purchase is consummated but only after receiving the indication that the customer is willing to make a purchase from the first merchant (Katz. et al.: col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6),

whereby the offer is not provided unless and until the indication is received;

g. receiving a response to the offer(Katz. et al.: col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6); and

h. applying the subsidy to the purchase if the response indicates acceptance of the offer(Katz. et al.: col 15, lines 59-65; col 17, line 54 to col 18, line 15; col 19, line 24 to col 20, line 23 and Figs 4-6).

In an analogous art, Donlon or Discount Store News teaches that it is known to use a cross-marketing approach to sell a product at discount via a subsidy from a second vendor to provide an incentive to the purchaser of the product (Donlon: abstract or Discount Store News: abstract and page 1, parag. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

Art Unit: 1751

modify the method as taught by Katz, with the cross-marketing approach as taught by Donlon or Discount Store News. One would have been motivated to modify the method with subsidizing for the price of a product/service with a related product/service for providing an incentive for the purchase of the initial product/service thus enhancing customer base via a combination of products and achieving greater profitability.

While Katz et al. and Donlon or Discount Store News do not explicitly disclose that the offer is from a second merchant who has been selected from a plurality of merchants based on the customer information, Logan discloses a similar method and further discloses providing an offer from a second merchant selected from a plurality of merchants based on the customer information (col 9, lines 23-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use customer information to present an offer to the customer. One would have been motivated to select the offer from a plurality of secondary merchants in order to give the customer greater latitude in the selection of the providers, thus increasing the likelihood that the customer would accept the offer.

Katz et al. disclose the second merchant (service provider) providing offers targeted to the specific customer, but does not explicitly disclose sending the customer information to the second merchant prior to receiving the targeted offer. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the second merchant would require the customer information in order to provide an offer targeted to that customer. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

IKatz et al. disclosure of providing targeted offers from the second merchant that the customer information has been received by the second merchant prior to selection of the offer. One would have been motivated to provide the customer information after receiving the indication that the customer is willing to purchase an item in order to allow new customers, whose information was just being collected, to participate in the customized offer system. In an analogous art, Spoor teaches a cross-marketing scheme with the feature of a service provider (Spoor: page 1, parag. 7-8 and page 2, parag.4). The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Art Unit: 1751

Claims 77 and 78 describe the apparatus and instructions of the method claim 61 thus the prior art references of Katz et al., Donlon or Discount Store News, Logan and Spoor as set forth above are relied upon to reject claims 77 and 78.

7. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al., Donlon or Discount Store News and Logan and in further view of Saxe (5,636,346).

Claims 34-40: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, and Saxe discloses determining the service provider of the customer as in Claim 33 above. However, none of the references disclose the steps involved in changing the customer to the new service provider upon receiving an indication of accepting such a change from the customer. Official Notice is taken that it is old and well known within the art to provide promotional offers for customers to switch from one service provider to another (i.e. AOL vs Prodigy vs Compuserve, etc.)(see page 2 of Stephen Ellis, "Credit Cards Firms Drive Down Costs", submitted by the Applicant as item GG on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). It is also well known that one will normally cancel any existing service agreement with another service provider when initiating a new service agreement with the second service provider (such as when switching long distance telephone service providers). It is also well known to check the second service provider's customer database to ensure that the requestor is not already a customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the second service provider to check for duplicate membership, to initiate a new service contract with the customer if not a duplicate, and to cancel any existing service contract with the other services providers. One would have been motivated do perform these steps in order to prevent duplication of services being provided to the customer.

Art Unit: 1751

8. Claims 20-28, 41,46-48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al., Donlon or Discount Store News and Logan and in further view of Weinblatt (5,515,270).

Claims 20-28: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 19 above, but do not disclose that the price is reduced by a predetermined amount or percentage or reduced to zero (free item) or that the reduction is taken if the price of the item is greater than the reduction amount. Weinblatt discloses a similar method in which the promotions (offers) "can involve coupons for lowering the price" . . . "2 for 1 sale, oversize containers sold for the same price, manufacturer rebates, combining one product with another product, free giveaways, eligibility for a prize drawing, etc." (col 8, lines 40-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that various types of offers could be utilized, to include price reductions based on a predetermined amount, a predetermined percentage, reduction of the price to zero (free give-a-way), etc. It also would have been obvious to limit the reduction to no more than the total price of the item being purchased. One would have been motivated to include these types of price reduction offers and to place such a limit on the reduction in order to increase the flexibility of the system while preventing the merchant from losing money by actually paying the customer to take the item (if the price reduction exceeded the price of the item).

Claims 41, 46, 47, and 50: Katz et al., Donlon or Discount Store News and Logan disclose the method as in Claim 1 above, but do not disclose that the offer is made only if the price of the item is greater than a predetermined threshold. Weinblatt discloses a similar method in which the offer (reward) is based on the purchase parameters, such as number of items, item cost, category of item, etc. (col 13, line 11 - col 14, line 19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base the offer on various parameters of the purchase information. One would have been motivated to use the price of the item or total payment amount in order to present offers customized to the purchase to increase the likelihood that the customer will accept the offer.

Art Unit: 1751

Claim 48: Katz et al., Donlon or Discount Store News and Logan disclose the method of Claim 1 above, and Weinblatt discloses basing the offer on the item as in Claims 41, 46, 47, and 50 above. Weinblatt also discloses that the advertiser will select the offer (col 13, line 11 - col 14, line 19). This infers that the advertiser is selecting the offer from a plurality of such offers (i.e. if the advertiser only had one offer, there would be no need to make a selection). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the offer from a plurality of offers. One would have been motivated to have a plurality of offers available in order to increase the range of customers and offers with matching parameters.

9. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al., Donlon or Discount Store News, Logan and Spoor and in further view of Tedesco (Broadcasting & Cable).

Claim 66: Katz et al., Donlon or Discount Store News, Logan and Spoor disclose the method of Claim 65 above but do not explicitly teach that the service comprises Internet service. In an analogous art, Tedesco teaches the use of cross-marketing between a phone company and America Online to provide Internet service (cols 1, 2 and 3 on page 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Katz et al., Donlon or Discount Store News, Logan and Spoor to include providing Internet service. One would have been motivated to apply the teachings of Tedesco to the method of Katz et al., Donlon or Discount Store News, Logan and Spoor to provide Internet service and thus enticing customers with a novel service, increasing and diversifying the customer base to achieve greater profitability.

10. Claims 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al., Donlon or Discount Store News, Logan and Spoor and in further view of Fleming et al. (Wall Street Journal).

Art Unit: 1751

Claims 67 and 68: Katz et al., Donlon or Discount Store News, Logan and Spoor disclose the method of Claim 65 above but do not explicitly teach that the service comprises insurance service or banking service. In an analogous art, Fleming et al. teaches the use of cross-marketing and cross-selling between the banking and insurance sectors ("bancassurance" and "assurfinance") to provide banking and insurance services (§ 1-3 on page 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Katz et al., Donlon or Discount Store News, Logan and Spoor to include providing banking and insurance services. One would have been motivated to apply the teachings of Colman to the method of Katz et al., Donlon or Discount Store News, Logan and Spoor to provide banking and insurance services and thus enticing customers interested in one item with an accompanying service, thus increasing and diversifying the customer base to achieve greater profitability..

11. Claims 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al., Donlon or Discount Store News, Logan and Spoor and in further view of Colman (Broadcasting & Cable).

Claims 69 and 70: Katz et al., Donlon or Discount Store News, Logan and Spoor disclose the method of Claim 65 above but do not explicitly teach that the service comprises satellite television service or cable television service. In an analogous art, Colman teaches the use of cross-marketing and cross-selling between the telephone, cable television and satellite television sectors to provide satellite television service and cable television service (§ 4 and 5 on page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Katz et al., Donlon or Discount Store News, Logan and Spoor to include providing satellite television service and cable television service. One would have been motivated to apply the teachings of Colman to the method of Katz et al., Donlon or Discount Store News, Logan and Spoor to provide service and thus enticing customers interested in one item with an accompanying service, thus increasing and diversifying the customer base to achieve greater profitability.

Art Unit: 1751

***Response to Arguments***

12. Applicant's arguments with respect to Claims 1-44, 46-50, 56-62 and 65-80 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

N VT

NVT

September 4, 2007



ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600